

Remarks

Claims 1-36, 56, 58-80, 97, 101, 108, 120 and 121. Before addressing the office action on the merits, Applicant would like to thank the Examiner for indicating that Claims 101, 108, 120 and 121 are allowed and that Claims 10, 17, 19, 20, 27, 35 and 36 are allowable.

35 USC § 103 Rejections

I. Claims 1-9, 11-16, 18, 21-26, 38-34, 56, 58-80 and 97 were rejected under 35 USC §103(a) as being unpatentable over Gudmundsson, et al, (WO 03/076441).

As pointed out by Applicant in the previous amendment, WO 03/076441 published on September 18, 2003 which is after the priority date of the present invention (U.S. Provisional Application No. 60/445728 filed on February 6, 2003). Therefore, this reference may be used for novelty rejections only and is not available as a reference for an obviousness rejection.

Even if the reference was available for use in an obviousness rejection, the Gudmundsson compounds are used in the prophylaxis or treatment of a condition or disease associated with a herpes viral infection which is non-analogous to the use of the compounds of the present invention which are CB-1 receptor antagonists. The presumption of obviousness based on a reference disclosing structurally similar compounds (e.g., positional isomers) may be overcome where there is evidence showing there is no reasonable expectation of similar properties in structurally similar compounds. *In re May*, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978). Clearly, compounds used in the prophylaxis or treatment of a herpes viral infection do not possess the same or similar properties of compounds which act as CB-1 receptor antagonists.

Based on the arguments presented above, Applicant respectfully submits that Claims 1-36, 56, 58-80, 97, 101, 108, 120 and 121 are in condition for allowance.

Respectfully Submitted:

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